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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,534	09/13/2005	Hubert Hauser	263605US6PCT	9522

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EXAMINER	
PARKER, FREDERICK JOHN	
ART UNIT	**PAPER NUMBER**
1762	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/518,534	HAUSER ET AL.	
	Examiner	Art Unit	
	Frederick J. Parker	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-34* is/are pending in the application.

4a) Of the above claim(s) *30-34* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4-21-05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 18-29 in the reply filed on 11-13-06 is acknowledged.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18,22,26,27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 18 is vague and indefinite because (1) on line 6 it is unclear HOW the surface of the marking filed is "modified" relative to the glass surface, since the modification is unstated; (2) on line 8, the meaning of the relative term "intimate" is unclear; (3) lines 8-9, the meaning of the phrase "which marking layer....using a mechanical mechanism" is indefinite if not impossible because there would be some mechanical means (sandblasting, hammer and chisel, diamond grinder, etc) capable of removing the marking . For examination, this is interpreted to mean indelible or scratch-proof. (4) lines 3-5 apply the marking to the glass but lines 8-9 apply the marking to the marking field on the glass; for examination, the latter interpretation is used.

- Claim 22 is vague and indefinite because the meaning of "locally limited" is unclear; line 3, the phrase "action hollows" is unclear since it is unstated what action refers to.
- Claim 26, "the coating" lacks antecedent basis, and further it is unclear to which of the 2 coatings it refers; for examination, it is interpreted to mean any coating.
- Claim 27 is vague and indefinite because it implies the marking field and marking stamp can be one and the same which is not accurate (see fig. 2 and associated text).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 18,20,21,22,26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Dauba WO 00/02825. (US 6430964 is used in lieu of a translation since it derived priority form the WO patent).

Dauba marks a glass pane to identify the treatment temperatures it has undergone by applying a marking substance which changes an optical characteristic in response to the temperature treatment, the substance applied to a glaze ("marking field") on the pane. The marking (test identification (= "marking stamp", per claim 27, trademark, reference, etc) is applied by, e.g. screen printing, after a thermal toughening/ tempering step. The marking will irreversibly turn color (e.g. yellow to brown, and is therefore "thermochromic") if the coated pane undergoes the thermal treatment such as a "heat soak test" (col. 5, 9-25). The marking is indelible so there is no

risk of marking removal during handling operations (col. 4, 14-38; col. 7, 25-34). The surface of the glaze which is marked inherently posses a coarser/ less smooth surface than glass. Dauba teaches marking only glazed surfaces, per claim 28.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 19,23-25,29 rejected under 35 U.S.C. 103(a) as being unpatentable over Dauba.

Dauba is cited for the same reasons previously discussed, which are incorporated herein. Per claim 29, Dauba teaches a temperature range of 270-330 C which overlaps the indictable temperature range of 180-340 C of claim 29. The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made if the overlapping portion of the indictable temperature range disclosed by the reference were selected because overlapping ranges have been held to be a prima facie case of obviousness, see In re Wortheim 191 USPQ 90. Per claims 23-25, Dauba does not cite an uneven coating surface. However, since both Dauba and claim 23 apply similar materials by the same method, e.g. screen printing, the final surface structure would also have been similar. Per claim 19, applying a glaze/ marking field prior to tempering treatment would have been obvious to allow simultaneous thermal treatment of the glaze and glass.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Dauba by using the recited temperature range and applying a marking having uneven surfaces onto any adherent surface because such variations would have been within the purview of one of ordinary skill to achieve equivalent results.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6037041; 4661305; 5684515 teach additional marking methods of glass surfaces which further illustrate the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426.

The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp